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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,320	11/14/2003	Gerhard Muller	30051/39651	1240

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EXAMINER
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PRICE, RICHARD THOMAS JR

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/713,320

Applicant(s)

MULLER, GERHARD

Examiner

Thomas Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-7-04 and 1-21-05. (3 PAGES)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The Information Disclosure Statements filed on 1-21-2005 and 5-7-2004 have been considered, a copy of each IDS is attached herewith.

### ***Election/Restrictions***

The Applicant's remarks concerning the outstanding restriction requirement mailed on 12-13-2004 have been reviewed with the following response. The method claim as claimed only calls for applying a clip. Various types of clips are applied to various types of objects everyday by using ones hands. The claim does not specifically state what type of clip is being used, nor is there any specific steps being claimed. Broadly, the claim states "any kind of clip". Only the step of "applying" is claimed. Further, the additional claim language of "by means of a clip module" broadly reads on a variety of clip manipulating tools, and there is no additional claim language to define this clip module. The claim only claims the step of using the clip module. Certainly, the hand or hands can operate the broadly claimed clip module by a vacuum filler, i.e. push a button, flip a switch, etc... Additionally, the hands can stuff a casing, the hands can separate the portions, apply a clip using a clip tool or module, and can drive(?) the clip module by the vacuum filler. The Applicant appears to be focusing on the apparatus portion of the method claim. However, only the process or steps need be performed by the hand. Although the Applicant discusses claim 1 and the additional claim language which has been added to the claim, it is believed that the additional claim language does not render the restriction improper. With regard to the Applicant's comments

concerning claim 12, the hands are able to operate a clip module to apply the clip. Lastly, with regard to the Applicant's comments concerning whether or not the search and examination of the entire application is a serious burden on the examiner, it is not a requirement for the Examiner to provide evidence in support of the restriction requirement as suggested by the Applicant. And it is not a determination made by the Applicant, but a decision made by the Examiner who must broadly interpret the claims in light of the specification. And as such, it is believed to be a burden on the Examiner. In conclusion, the restriction requirement mailed on 12-13-2004 is FINAL.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

(1) the clip module comprises a part which is adapted to be rotatably driven by the vacuum filler and by means of which the clip module can be driven (claims 2 and 3);

(2) the shaft being connected to the vacuum filler for driving the clip module (claim 4);

(3) the clip module comprises a displacer (claim 5);

(4) means provided for inserting one of a thread and a loop when the clips are being set (claim 6);

(5) a separator(16) is provided for separating respective portions(claim 7);

(6) a servomotor of the vacuum filler used for driving the clip module(claim 8);

(7) a twist off unit is provided adjacent to a stuffing means for the vacuum filler(claim 10);

(8) the suspension unit being one of controlled and driven by the vacuum filler and clip module;

(9) servomotor is adapted to be used for one of twisting off and for driving other functions;

(10) the control circuit is provided for additionally one of positioning, clipping, and both positioning and clipping;

(11) one of the thread and loop is attached when the clip is being set  
must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claimed "control circuit" in claim 19 lacks prior antecedent basis in the specification.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-8, 10, 11 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regards to claims 2 and 3, the clip module having a **part** which is adapted to be rotatably driven by the vacuum filler and the clip module having a **part** which is rotatably driven and by means of which the clip module can be driven is not shown in any way, nor is there sufficient discussion in the specification to understand how such a feature operates.

As for claim 4, the shaft being connected to the vacuum filler for driving the clip module is not clearly shown in any manner, nor is there sufficient discussion in the specification in order to understand how such a claimed feature works.

Regarding claim 5, displacer 7 is merely shown as two lines 7a and 7b in the drawings. The Examiner cannot discern from the drawings and the specification as to how these elements function.

Similarly, in claim 6, inserting one of a thread and a loop **when** the clips are being set. Claim 7, the separator 16 is not shown and the specification is lacking as to how this element functions. Claim 8, a servomotor used for **driving** the clip module. Claim 10, the twist off unit is not clearly shown nor discussed in the specification. Claim 11, the suspension unit being one of controlled and driven by the vacuum filler and the clip module. Claim 17 is dependent upon a previously rejected claim 4. See also claims 18-20.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kupcikevicius et al U.S. Patent 4,044,426.

Kupcikevicius et al teach a stuffing apparatus having a vacuum filler and a clip module driven by the vacuum filler. A control unit is provided. The remaining claim language "for stuffing a casing", "for applying a clip" and "for controlling the stuffing, the portioning and the clipping" are considered to be functional claim language which does not patentably distinguish the claimed invention over the reference to Kupcikevicius et al.

### ***Conclusion***

Summary: Claims 1-11 and 17-20 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Price whose telephone number is 571-272-6892. The examiner can normally be reached on Monday through Friday from 8:30a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Thomas Price  
Primary Examiner GAU: 3643

rtp